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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/797,096   | 03/11/2004  | Paul Elia            | 6786-10 SJP         | 4595             |
| 7590   | 05/20/2005  |                      | EXAMINER            |                  |
| Stephen J. Perry<br>Sim & McBurney<br>6th Floor<br>330 University Avenue<br>Toronto, M5G 1R7<br>CANADA |             |                      |                     | LE, MARK T       |
|  |             |                      |                     | ART UNIT         |
|  |             |                      |                     | PAPER NUMBER     |
|  |             |                      |                     | 3617             |
| DATE MAILED: 05/20/2005  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/797,096             | ELIA, PAUL          |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Mark T. Le             | 3617                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 April 2005.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-2, 4, 8-18 is/are rejected.

7) Claim(s) 3 and 5-7 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This communication is responsive to the amendments, filed on April 7, 2005. Applicant's amendments and remarks have been carefully considered.
2. Claims 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (US 2,665,848).

Smith discloses a toy train track system having all the features as recited in the instant claims, including a pair of rails 13 supported on railroad bed 20 and ties 14.

Note that railroad bed 20 and ties 14, assembled as shown in Figure 1 of Smith, form a substantially flat surface between rails 13 that is readable as at least one travel surface that is capable of supporting a toy roadway vehicle that is guidable by said rails 13.

Regarding the instant claimed two travel surfaces, as recited in instant claim 14, note that said travel surface of Smith, as described above, inherently includes two travel surfaces, i.e. the left and right portions forming left and right travel surfaces.

3. Claims 1-2, 8-12 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Baynes (US 3,734,404).

Baynes discloses a toy roadway vehicle track having all the features recited in the instant claims, including travel surface 14, guiding features 18, 20, and a bottom surface forming a support surface that is capable of being placed on top and in contact with a toy train track such that the roadway vehicle track of Baynes is capable of being used as an adapter system as claimed.

Regarding the instant claimed adapters being dimensioned to fit between the set of rail of a toy train track, as recited in instant claim 2, it is considered that the track

(adapter) of Baynes would inherently fit between the set of rails of a toy train track of a larger gauge than the width of the track of Baynes.

Regarding the instant claimed recess for receiving connecting elements of rails and ties, as recited in instant claim 8, consider the lateral spaces outside of ribs 22 and 24 of Baynes, which spaces are readable as recesses that are capable of receiving connecting elements as claimed.

Regarding the instant claimed gap recited in claim 12, note that spaces on the bottom face of the track of Baynes are readable as providing at least one gap that is usable for the instant claimed purpose.

Regarding the instant claimed intended uses of the claimed adapters with a certain toy train track with the set of rails, as defined in instant claims 15-18, note that since the structure of Baynes is inherently capable of being used with toy train tracks having larger gauges between rails than the width of the structure of Baynes, the instant claimed intended use limitations are considered met.

4. Claims 1-2, 4 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Northrop (US 2,687,304) in view of Baynes (US 3,734,404).

Northrop, Figures 1, 5 and 6, shows a toy roadway vehicle track similar to that recited in the instant claims, including a travel surface on top of base 1, guiding feature 34 or 40, and the bottom surface of base 1 forming a support surface that is capable of being supported on and in contact with a toy train track, that has a track gauge corresponding to base 1 of Northrop, such that the roadway vehicle track of Northrop is capable of being used as an adapter system as claimed in claims 1-2 and 4.

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Regarding the instant claimed plurality of adapters (track sections) connected to form a continuous track length, as recited in instant claim 1, note the track of Baynes, which are formed by a plurality of track sections that are designed to be connected together to form a continuous track length. In view of Baynes, it would have been obvious to one skilled in the art to form the track of Northrop in multiple connectable sections, in a manner similar to that taught by Baynes, so as to achieve expected advantages thereof, such as greater flexibilities in configuring different track layouts.

Regarding the instant claimed intended uses of the claimed adapters with a certain toy train track with the set of rails, as defined in instant claims 15-18, note that since the structure of Northrop is inherently capable of being used with toy train tracks having larger gauges between rails than the width of the structure of Northrop, the instant claimed intended use limitations are considered met.

5. Responses to Applicant's Arguments:

It is noted that Applicant's arguments are mainly directed to the instant claimed intended uses or associations with the set of rails of a toy train track and other vehicles; where in claims 1-12 and 15-18, the recited toy train tracks are not required as to be in combination with the instant claimed adapters. Under this circumstance, the specifics of the toy train tracks in an intended use or association with the instant claimed adapter are not needed to be shown or suggested in the prior art to establish a proper ground of rejection. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim, i.e. the prior art does not have to show or suggest the claimed intended uses. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Similarly, since the structures of the above applied prior art are inherently "capable" of being used as recited in the instant claims, then the structures meet the claims.

As to Applicant's argument that the rail clips in Smith's structure would present obstructions for another type of vehicles to travel along the space between the rails, Applicant should note that instant claims 13-14 do not specific claim the toy train track system in positive combination with another type of vehicles that have specifics wheel configurations that would be obstructed by the presence of the rail clips of Smith. Therefore, Applicant's argument that the rail clips of Smith would present obstructions to a certain not-claimed vehicle is deemed to be a non-issue because the limitations of the instant claims are not as specific as argued by Applicant.

6. Claims 3 and 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Le whose telephone number is 571-272-6682. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark T. Le  
Primary Examiner  
Art Unit 3617

mle  
1/21/04